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09/693,790	10/20/2000	Dean F. Jerding	A-6689	8529

  

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SCIENTIFIC-ATLANTA, INC.		
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EXAMINER	
SHANG, ANNAN Q	

  

ART UNIT	PAPER NUMBER
2623	

  

NOTIFICATION DATE	DELIVERY MODE
01/15/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@sciatl.com

## Office Action Summary

**Application No.**

09/693,790

**Applicant(s)**

JERDING ET AL.

**Examiner**

Annan Q. Shang

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 117-164 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 117-164 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/07 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 10/19/07 have been fully considered but they are not persuasive.

With respect to claims 117-129, 132-146 and 149-160 rejected under 35 U.S.C. 102(e) as being anticipated by **Nishikawa et al (6,481,010)**, applicant amends some claims and argues that the prior art of records Nishikawa, does not disclose the highlighted claim limitations (see page 11+ of Applicant's Remarks).

In response, Examiner disagrees. Examiner notes applicant's arguments, however, Nishikawa teaches a plurality of storage devices (VCR, HDD, flash memory, SDRAM, etc.,) that stores various sets of media information. Nishikawa teaches that DSS/WebTV Receiver 12, receives DSS/Internet data (EPG data, website data, etc.,), stores the data in the various storage units to permit a user to access information (including web-sites data in real time), periodically downloads the data (col.6, lines 15-

59) and further teaches that incoming data is stored in a selected memory location, HDD, Memory 230, VCR, etc., (col.7, line 44-col.8, line 1, col.9, lines 53-63). The guide or GUI data and the media data is stored in the storage devices and upon a user interaction to the guide or GUI (which includes providing search terms) the processor searches the various storage units to receiver the search results. Nishikawa further permits a user to select programs for viewing/recording (col.2, lines 6-26, col.5, lines 49-65, col.6, lines 14-43, col.9, line 53-col.10, line 35 and col.13, lines 19-45); Nishikawa further teaches the use of a keyboard to enter a search term, which meets the claimed limitation "...user a search option to search media programs; responsive...searching the first and second storage devices for media information having a high level of correlation..."(col.2, lines 6-26, col.14, line 53-col.15, line 33, line 34-col.16, line 19). However, if Applicant disagrees with the Examiner's assertion, then it would have been obvious the search term would be the title of the program. Hence it would have be obvious to one of ordinary skill in the art at the time of the invention to modify Nishikawa to include a title to be enter for searching, so as to provide to the user an alternate way to search besides actor's name, sport team's name, movie director's name, etc. Furthermore, DSS processor 200 searches HDD-288 and/or memory 230 and other storage devices attached via 1394 cabling for a listing having a high correlation with the search term, including program(s) purchases to view or record and purchased programs, where the search terms are entered by the user using and input device or highlighting various elements on the on-screen keyboard 700. Hence applicant's arguments/amendments do not overcome the prior art of record. The 102(e) and 103(a)

rejection meets all the claim limitations as discussed below. **This office action is non-final.**

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 117-129, 132-146, 149-160 and 164 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Nishikawa et al (6,481,010)**.

As to claim 117, note the **Nishikawa** reference figures 1-2 and 9-20, discloses an integrated Direct Satellite System/WebTV 'DSS/WebTV' receiver and further discloses a method for enabling a user to search for media programs, the method comprising:

Enabling a user to record a first set of media programs in a first storage device with a digital personal video recorder (PVR) (col.2, lines 6-26, col.5, lines 49-65, col.6, lines 14-43 and col.13, lines 19-45);

Storing media information corresponding to the first set of media programs in the first storage device, the media information including information related to at least a title

and media type for each media program (col.9, line 53-col.10, line 35 and col.13, lines 19-45);

Receiving media information corresponding to a second set of media programs that are currently being broadcast; receiving media information corresponding to a third set of media programs that are to be broadcast in future; storing the media information corresponding to the second and third sets on the media programs in a second storage device (col.9, line 53-col.10, line 35 and col.13, lines 19-45);

Providing to the user a search option to search for media programs; responsive to the user activating the search option, enabling the user to enter a search term; responsive to the user entering a search term (figs.17-18, col.14, line 53-15, line 63), searching the first and second storage devices for media information having a high level of correlation with the search; and providing a list of media programs corresponding to the media information having a high level of correlation with the search term and implementing an ST to provide the list on a TV (col.3, line 61-col.4, line 7, col.9, lines 53-col.10, line 35, col.14, line 53-col.16, line 19), note that the DSS processor 200 searches HDD-288 and/or memory 230 and other storage devices attached via 1394 cabling for a listing having a high correlation with the search term, including program(s) purchases to view or record and purchased programs, where the search terms are entered by the user using an input device or highlighting various elements on the on-screen keyboard 700.

Nishikawa teaches a plurality of storage devices (VCR, HDD, flash memory, SDRAM, etc.,) that stores various sets of media information and further enables a user

to select programs for viewing/recording on a first storage device (VCR) with a personal video recorder (PVR), storing media information corresponding to the first set of media programs in the first storage device, the media information including information related to at least a title and media type for each media program, listing all PPV purchased, recorded programs and programs to be broadcast in future; Nishikawa further the use of a keyboard to enter a search term, which meets the claimed limitation "...user a search option to search media programs; responsive...searching the first and second storage devices for media information having a high level of correlation..."(col.2, lines 6-26, col.14, line 53-col.15, line 33, line 34-col.16, line 19).

However, if Applicant disagrees with the Examiner's assertion, then it would have been obvious the search term would be the title of the program.

Hence it would have be obvious to one of ordinary skill in the art at the time of the invention to modify Nishikawa to include a title to be enter for searching, so as to provide to the user an alternate way to search besides actor's name, sport team's name, movie director's name, etc.

As to claims 118-123, Nishikawa further discloses where responsive to the user activating the search option, further enabling the user to enter a search criteria based on a range of start times of the media programs, and where searching the first and second storage devices further comprising searching for media information corresponding to media programs having a start time within the range of start time, where the user enter a search criteria based on a range of start times comprises enabling the user to select time period from a plurality of time periods and the time

period is selected from time periods specified by dates, where the dates are actual dates, are relative dates and includes "Today only, Today and Tomorrow and next 7 days (col.15, line 10-col.16, line 37).

As to claims 124-127, Nishikawa further discloses where the media information in the second storage device includes information indicating that a particular media program is a purchasable program, providing, with the list of media programs, an indication that the particular media program is a purchasable program, where the particular media program is a VOD and PPV program and providing the list of media programs, an indication that the media programs stored in the first storage device are programs recorded by the PVR, where the PVR is a RAM (col.13, 19-67).

As to claims 128-129, Nishikawa further discloses where when the media information in the second storage device includes information indicating that a particular media program is available via a subscription service, providing with the list of media programs, indication that the particular media program is available via subscription service (col.13, 19-67).

Claim 129 is met as previously discussed with respect to claim 117.

As to claim 132, the claimed "A set-top terminal (STT) comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claim 117.

As to claim 133, Nishikawa further discloses where the PVR is embodied within the STT (col.5, lines 38-65).



As to claim 134, Nishikawa further discloses where the PVR is external to the STT (col.3, lines 55-60).

Claims 135-140 are met as previously discussed with respect to claims 118-123.

Claims 141-144 are met as previously discussed with respect to claims 124-127.

Claims 145-146 are met as previously discussed with respect to claims 128-129.

As to claim 149, Nishikawa further discloses an interactive media services system comprising:

A memory (HDD 228/Memory 230) of storing media information, the media information including information related to a title, start time, and media type for each of the plurality of media programs; a software program store in memory (col.5, lines 38-65), the software program comprising a plurality of executable functions;

A processor (DSS Processor 200) configured to execute the software program, wherein executing the software includes: the claimed method step of "enabling a user to record a first set of media programs..." is composed of the same structural elements that were discussed with respect to the rejection of claim 117.

Claims 150-155 are met as previously discussed with respect to claims 118-123.

Claims 156-159 are met as previously discussed with respect to claims 124-127.

Claims 160-161 are met as previously discussed with respect to claims 128-129.

Claim 164 is met as previously discussed with respect to claims 124-127.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 130-131, 147-148 and 162-163 are rejected under 35 U.S.C.

103(a) as being unpatentable over **Nishikawa et al (6,481,010)** as applied to claims 117, 132 and 149 above, and further in view of **Koshimuta (6,515,710)**.

As to claims 130-131, 147-148 and 162-163, **Nishikawa** fails to explicitly teach where the search option includes media information stored in the memory of the STT for media programs that satisfy at least one search criterion based on the quality of the media and further determining if it's a HDTV video signals

However, note the **Koshimuta** reference figures 1-5, disclose a television receiver that determines the video signal format based on data characterizing of the video signal being received and further determines if it's a HDTV, SDTV, NTSC, etc., video signals (col. 1, lines 9-19, col. 2, line 43-col. 3, line 24, col. 4, line 44-col. 5, line 9).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Koshimuta into the system of Nishikawa to identify the media quality of each media program to enable the user to beware of type of signal being received to enable the user to choose a signal type (HDTV, SDTV, NTSC, etc.,) that meets their receivers and to enable the receivers to reproduced the precise colors that meets manufactures specification or the receiver's capabilities.

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', with a stylized flourish at the end.

**Annan Q. Shang**